

### **REMARKS**

This is in response to the Office Action mailed September 19, 2006. Minor amendments have been made to element formatting in Claims 1, 13, 14, 25, and 26; no new matter is added therewith. Reconsideration of this application is respectfully requested in view of this response/amendment.

### **STATUS OF CLAIMS**

Claims 1-26 are pending.

Claims 1-26 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-37 of co-pending application 10/774,594.

Claims 1-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wang et al., “*An Efficient XML Schema Typing System*”.

Minor amendments have been made to element formatting in Claims 1, 13, 14, 25, and 26; no new matter is added therewith.

### **DOUBLE PATENTING REJECTION**

The Examiner has provisionally rejected the instant application with serial no. 10/774,584 based on the copending application, also to the same assignee, with serial no. 10/774,594 titled “Efficient XML Schema-Validation of XML Fragments Using Annotated Automation Encoding”, both of which were filed on 02/10/04.

As per M.P.E.P §804 I.B.1:

If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Applicants wish to note that the current response is accompanied by a terminal disclaimer that has been filed with respect to the instant application with serial no. 10/774,584, whereby a terminal part of any patent granted on the instant application with serial no. 10/774,584 which would extend beyond the expiration date of the full statutory term of a patent having serial no. 10/774,594.

Based on the accompanying terminal disclaimer, Applicants, hereby, respectfully request the Examiner to withdraw the provisional double patenting rejection with respect to the instant application in accordance with M.P.E.P. guidelines.

Applicants also wish to note that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection (*Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991)). The Examiner is reminded that the courts have indicated that the "filing

of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

### OBJECTIONS TO THE DRAWINGS

As mentioned earlier, appropriate amendments have been to the specification to recite such reference characters, without adding new matter. With respect to Figure 3, an amended Figure 3 is submitted herewith. Applicants respectfully request the Examiner to withdraw the objections to the drawings.

### REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected pending claims 1-26 under 35 U.S.C. 102(e) as being anticipated by a non-patent literature titled "An Efficient XML Schema Typing System" by Wang et al. Applicants assert, and as will be shown below, that the Examiner has issued an improper 35 U.S.C, 102(e) rejection.

According to 35 U.S.C. §102(e), a person shall be entitled to a patent unless - the invention was described in - (1) **an application for patent**, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a **patent granted on an application for patent** by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed

in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Applicants respectfully assert that the Examiner relies on 35 U.S.C §102(e) which references patents, and NOT publications.

Applicants, therefore, assert that the Examiner has issued an improper 35 U.S.C, 102(e) rejection in the Office Action of 09/19/2006 and, hereby, request the Examiner to withdraw the 35 U.S.C. 102(e) rejection with respect to the pending claims 1-26.

#### SUMMARY

As has been detailed above, none of the references, cited or applied, provide for the specific claimed details of applicants' presently claimed invention, nor renders them obvious. It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested.

As this response has been timely filed, no request for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided to Deposit Account No. 09-0460.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,

*/randywlacasse/*

Randy W. Lacasse  
Registration No. 34368

1725 Duke Street, Suite 650  
Alexandria, Virginia 22314  
(703) 838-7683

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